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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,804

01/23/2007

Chunlin Tao

252846

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7590

02/22/2008

LEYDIG VOIT & MAYER, LTD  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON AVENUE  
CHICAGO, IL 60601-6731

EXAMINER

SHITERENGARTS, SAMANTHA L

ART UNIT

PAPER NUMBER

4131

MAIL DATE

DELIVERY MODE

02/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/583,804

**Applicant(s)**

TAO ET AL.

**Examiner**

SAMANTHA SHTERENGARTS

**Art Unit**

4131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Due to the complex nature of the claims, no request for oral election is made. Please see MPEP 812.01.

Claims 1-36 are currently pending in the instant application and are subject to lack of unity requirement.

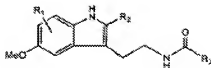
### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

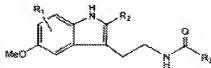
This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. **Group I**, Claims 1-18 and 21-26 drawn to compounds of the following formula:

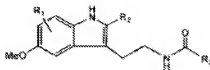


- II. **Group II**, Claims 19-20 drawn to methods of preparing compounds of the following formula:

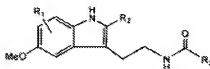


- III. **Group III**, Claims 27-30 drawn to methods of inducing sedation, hypnosis and/or sleep, or general anesthesia in a patient by administering compounds of the following formula:

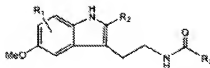
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- IV. **Group IV**, Claims 31-32 drawn to methods of treating sleep disorders or chronobiological disorders in a patient by administering compounds of the following formula:



- V. **Group V**, Claims 33 -36 drawn to methods of treating a condition affected by melatonin activity in a patient by administering compounds of the following formula:



In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

An international application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept (PCT Rule 13.1).

With respect to a group of inventions claimed in an international application, unity of invention

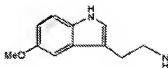
Art Unit: 1654

exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features.

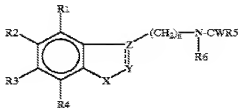
The claims herein lack unity of invention under PCT rule 13.1 and 13.2 since, under 37 CFR 1.475(a)

Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

**Group I** lacks unity of invention since under 37 CFR 1.475: the technical feature corresponding to the claims is shown below:



This core technical feature is not a special technical feature because it fails to define a contribution over the prior art as can be seen in Fourtillan et al. (U.S. Pat # 6,004,991) which discloses the same core in Claim 1, where X is N, n is 3, R<sup>2</sup> is MeO, R<sup>1</sup>, R<sup>3</sup>, R<sup>4</sup> are H, and Y=Z is C=C. Below is a figure of the prior art from Fourtillan.



Therefore, claims 1-18 and 21-26 are not so linked as to form a single general inventive concept and there is a lack of unity of invention because they lack a special technical feature as the technical feature present fails to define a contribution over the prior art. The core technical feature that is being claimed is taught by the prior art. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

Therefore, since the claims do not relate to a single general inventive concept under PCT Rule 13.1 and lack the same or corresponding special technical feature, the claims lack unity of invention and should be limited to only a product or a method of use.

Furthermore, in regards to groups I and (II , III, IV, and V), even if unity of invention under 37 CFR 1.475(a) is not considered lacking, which it is, under 37 CFR 1.475(b) a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of said product, and a use of said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of said product, and an apparatus or means specifically designed for carrying out the said process.

And according to 37 CFR 1.475(c): if an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b), unity of invention might not be present.

Therefore, since the claims are drawn to more than a product and a method of use, and according to 37 CFR 1.475(c): the determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claims.

The claims, therefore, lack unity of invention.

### ***Election of Species***

As an additional requirement, with the election of one of groups I, IV, or V, a provisional election of species of a particular compound is also required. In order for this election to be considered fully responsive to this requirement the election **must include**:

#### **Group I:**

- a) the compound name and structure,
- b) the location of the species within the claims (11 or 12) or the specification,
- c) the claims that read on the elected species,
- d) and a definition of the exact substitutions,

e.g. R<sub>1</sub> is Hydrogen, X is oxygen, etc...

#### **Group IV:**

- a) A method of administration from claims 29 or 30. Select from: oral administration, nasal respiratory administration, bolus injection, intravenous administration, continuing

infusion, rectal administration, vaginal administration, sublingual administration, or cutaneous administration.

**Group V:**

a) A method for treating a condition affected by melatonin activity where the condition can be found in claims 35 and 36. Select from: depression, epilepsy, jet-lag, work-shift syndrome, sleep disorders, glaucoma, reproduction, cancer, premenstrual syndrome, immune disorders, inflammatory articular diseases, neurodegenerative diseases of the central nervous system, or neuroendocrine disorders.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 29, 30, 35, and 36 are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., different electronic resources, classes/subclasses, or employing different search queries; and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different prior-art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.



The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samantha Shtrengarts whose telephone number is (571)270-5316. The examiner can normally be reached on Monday thru Thursday, 8AM – 5PM Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, Cecilia Tsang and Janet Andres can be reached on 571-27—0562 and 571-272-0867, respectively. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SAMANTHA SHTERENGARTS/  
Examiner, Art Unit 4131

/Cecilia Tsang/

Supervisory Patent Examiner, Art Unit 4131